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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/972,855	10/10/2001	Yoshiaki Sugizaki	04329.2686	5564
22852	7590	09/22/2005		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER IM, JUNGHWA M	
			ART UNIT 2811	PAPER NUMBER

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

AK

Office Action Summary	Application No.	Applicant(s)
	09/972,855	SUGIZAKI, YOSHIAKI
	Examiner	Art Unit
	Junghwa M. Im	2811

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 05 July 2005.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,2,4-11,14-18 and 25 is/are pending in the application.
 - 4a) Of the above claim(s) 1,2,4-11 and 14-18 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 25 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hsuan (US 6429509) in view of Dore et al. (US 6239484), hereinafter Dore.

Regarding claim 25, Fig. 3C of Hsuan shows a semiconductor device comprising:
a first semiconductor chip [300(1)] where a semiconductor element is formed;
a plurality of first connecting terminals (connecting bumps) arranged on a semiconductor element formation surface side (an active area above the dashed line) in the first semiconductor chip, and connected electrically to the semiconductor element the first connecting terminals having, substantially the same configuration;

a plurality of conductive members [410 in Fig. 4K] buried in a plurality of through holes that extend through the first semiconductor chip;

a plurality of second connecting terminal terminals arranged on a back surface side of the semiconductor element formation surface in the first semiconductor chip, and connected electrically to the semiconductor element via the conductive members (col. 7, lines 13-45);

a second semiconductor chip [300(2)] stacked on the first semiconductor chip;

a plurality of third connecting terminal terminals arranged on a semiconductor element formation surface side in the second semiconductor chip, wherein one of the first connecting

terminals and the second connecting terminals of the first semiconductor chip is arranged at a position facing the third connecting terminals of the second semiconductor chip, the first semiconductor chip and the second semiconductor chip are electrically connected with each other through the facing connecting terminals,

some of the first connecting terminals or the second connecting terminals are distributed and arranged substantially on an entire surface of the semiconductor chip to receive a power source supply potential or ground potential (col. 5, lines 21-44).

Fig. 3C of Hsuan shows most aspect of the instant invention except “the second semiconductor chip is thicker or larger than the first semiconductor chip.” Fig. 3 of Dore shows a semiconductor device wherein the second semiconductor chip/ an upper chip thicker or larger than the first semiconductor chip/a lower chip.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate the teachings of Dore into the device of Hsuan in order to the second semiconductor chip/ an upper chip thicker or larger than the first semiconductor chip/a lower chip to accommodate the design specification.

Response to Arguments

Applicant's arguments filed July 5, 2005 have been fully considered but they are not persuasive.

Applicant mainly argues that “Accordingly, the Examiner has failed to provide sufficient motivation for combining the references, and has thus failed to establish a *prima facie* case of obviousness.” The Examiner recognizes that references cannot be arbitrarily combined and that

there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 189 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 595 (CCPA) 1969.

Furthermore, the instant invention does not disclose that having an upper chip larger and thicker is critical to the recited structure. Rather, it is disclosed that such a configuration is one of the embodiments.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Junghwa M. Im whose telephone number is (571) 272-1655. The examiner can normally be reached on MON.-FRI. 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, Stephen Loke can be reached on (571) 272-1657. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jmi

P: 202-205-6000
Stephen Loke